

### REMARKS

The Office Action rejected Claims 1-6 and 8-23. Applicants amended claim 1. Claims 1-6 and 8-23 remain. Applicants respectfully request that the Examiner reconsider and withdraw the rejections. A Petition for a three (3) month extension of time accompanies this Amendment as a separate paper.

#### **Claim Rejections - 35 USC § 102**

The Office Action rejected Claims 1-6 as being anticipated by U.S. Patent No. 5,205,465 to Bogard et al. ("Bogard"). In the rejection, the Examiner stated that "applicant has provided no specific definition of the 'direct' heating claimed in the process" and, as a result, the induction heating of Bogard "is deemed to be direct heating." Applicants clarified independent claim 1, which now states that the heating of the contact areas is accomplished "through direct contact" of the contact areas. Bogard fails to disclose or to suggest such a feature. The induction heating of Bogard (*i.e.* radiative heat transfer) occurs through the space between the induction coil and the contact areas. None of the remaining cited references provide a motivation for such a modification. Applicants request that the Examiner reconsider and withdraw the rejection.

#### **Claim Rejections - 35 USC § 103**

The Office Action rejected claims 8-23 as being unpatentable over Bogard in view of U.S. Patent No. 5,272,809 to Robertson et al. ("Robertson"). Applicant asserts that the rejection was improper and must be withdrawn. Specifically, the Office Action failed to establish a *prima facie* case of obviousness.

A *prima facie* case of obviousness must meet three criteria. M.P.E.P. § 2143. First, a motivation must exist to combine the references. *Id.* Second, the combination must have a reasonable expectation of success. *Id.* Finally, the references must teach or suggest all the claim limitations. *Id.* Applicants believe the Office Action failed to establish a valid motivation to combine the references.

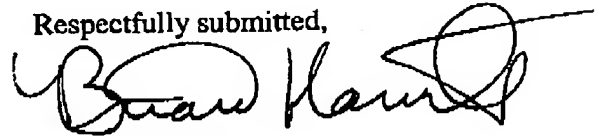
The Office Action states that “[i]t would have been obvious to modify ... Bogard et al. ... because Robertson et al. teaches the resistance heating means is used in a forge joining repair process to successfully achieve the same temperatures that Bogard et al. requires.” That statement, however, is a discussion of the teachings of Robertson and not a discussion of motivation. In fact, nowhere does the rejection discuss any motivation to combine the references. For at least this reason, the rejection was improper and must be withdrawn.

### Conclusion

In light of the foregoing, Applicants submit that the claims are now in condition for allowance. Applicants request that the Examiner reconsider and withdraw the rejections. Applicants solicit the allowance of Claims 1-6 and 8-23 at an early date.

Applicants authorize the Commissioner to charge any fee due under 37 CFR 1.16 or 17, or to credit any overpayments, during prosecution of this Application, to Deposit Account Number 21-0279.

Respectfully submitted,




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